

### REMARKS

Entry of this Amendment is proper under 37 CFR §1.116, since no new claims or new issues are presented and the Examiner needs to clarify and justify the USPTO position prior to proceeding to Appeal.

More specifically, the rejection currently of record continues to fail to meet the initial burden of a *prima facie* rejection by failing to provide a reasonable motivation to modify the primary reference. At best, the rejection currently of record merely identifies a missing element and then proceeds to summarily declare obviousness by reason that the missing element is known in the art and is, therefore, merely available to provide the benefit of the missing element.

Applicants respectfully submit that such cursory analysis fails to meet the intended initial burden of the Examiner, since this approach fails to recognize that the primary reference Muhme already defines a perfectly functioning system. At best, the cursory analysis of the current rejection merely provides a series of references that demonstrate that Muhme could be "improved" by incorporating the missing elements provided by the roadmap of the claimed invention.

That is, the Examiner points to no suggestion in the prior art references themselves that reasonably suggest the unique combination of elements defined in the claimed invention. Although the USPTO is given the latitude (reference MPEP 2145 X. A.) of considering that "... *but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper*", Applicants submit that in the present evaluation, the USPTO fails to recognize that the primary reference Muhme clearly teaches against making the modification necessary to comply with the independent claim, as explained in more detail below.

It is brought to the Examiner's attention that, prior to proceeding in the Appeal process, the Examiner might want to read the *McLaughlin* case holding from which the above oft-recited lines are taken, since it is noted that the Court in that case actually reversed the Board's rejection of claim 15, in spite of its strong statement recited above, and affirmed the rejection of claims 13 and 14 only because the record failed to contain a reasonable rebuttal by the Applicant.

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Therefore, Applicants submit that, although the MPEP contains these lines from *McLaughlin*, the MPEP fails to warn the Examiner that such lines should be interpreted only in the context of the specific facts and specific holding of that case. That is, these isolated lines from case law should not be construed as loopholes that undercut in the Examiner's burden to provide an objective and reasonable prior art evaluation.

Second, the Examiner continues to ignore the plain meaning of the claim language. Indeed, as identified below, the rejection currently of record effectively fails to even acknowledge the existence of a number of claims by this technique.

It is submitted that the claims are not further substantively adjusted herein and no further such adjustments are possible until someone at the USPTO engages in an objectively meaningful analysis and dialog for the plain meaning of the claim language.

Claims 1-2, 4-6, 8-16, and 18-29 are all the claims presently pending in the application. It is noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1, 4-7, 10, 15, and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme (U.S. Patent No. 5,886,634), further in view of Yeadon (U.S. Patent No. 6,393,339).

Claims 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of U.S. Patent No. 4,881,061 to Chambers.

Claims 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of U.S. Patent No. 5,883,582 to Bowers et al.

Claims 2 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, further in view of U.S. Patent No. 5,984,388 to Bacon.

Claims 8 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of U.S. Patent No. 6,297,727 to Nelson.

Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon and Nelson, and further in view of US Patent 5,745,036 to Clare.

Claims 9, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of US Patent 4,471,343 to Lemelson.

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These rejections are respectfully traversed in the following discussion.

## **I. THE CLAIMED INVENTION**

Applicant's invention, as defined, for example, in a non-limiting embodiment of independent claim 1 (and substantially similarly by independent claims 15 and 21) is directed to a system (and method) system for preventing theft of an object.

An electronic article surveillance (EAS) device is operatively attached to an object. A security path, including at least one security gate, detects the EAS device. A reader is operatively coupled to the security path near one of the security gates. A smart card containing an identification profile of an authorized user is readable by the reader.

A computer attached to the reader disables the security function of the security path at the security gate if a person presenting the smart card at the reader is determined as being authorized to remove said object after having said smart card read by said reader.

With such features, an authorized user of an object in an office environment who exhibits a smart card either does not trigger the alarm or is allowed free passage with the tagged object or the alarm is reset. Or, in an exemplary sales environment, if a retail clerk forgets to remove the EAS device after a legitimate sale, the present invention allows an authorized user, such as a security guard standing near the exit, to reset the alarm by presenting a smart card to the smart card reader located nearby, thereby allowing the alarm to be reset without having to leave the exit area to reset the alarm.

Therefore, the present invention allows a secure method to easily reset a detected security breach that has been activated due to an error. That is, although the card reader might be readily accessible, only a holder of a smart card will be able to reset the system upon activation due to an error. Further, in the office environment, fast reliable tracking of personnel carrying objects (e.g., such as personal computers) into/or of an area can be achieved.

The conventional systems, such as those discussed below and in the Related Art section of the present application, do not have such a structure, and fail to provide for such an operation (e.g., see page 6, lines 18-22 and page 7, lines 1-7 of the present application).

Such features are not taught or suggested by any of the cited references. That is, the present invention includes a new combination of elements such that both a tag attached to an

object and a smart card are uniquely combined in an unobvious manner to provide features that are not available in the prior art of record, even if the prior art references were properly combinable.

That is, Applicants submit that the present invention is indeed a new combination of elements, particularly since the prior art references do not teach or suggest using a smart card to temporarily disable the security function at a security gate, including, as clearly described in various claims, turning off the alarm previously set off and/or interacting with a video camera in various ways.

## II. THE PRIOR ART REJECTIONS

Applicants submit that the current rejection of record now needs clarification prior to proceeding to Appeal. For convenience of the Examiner, the following deficiencies are identified.

Relative to claim 1, the Examiner characterizes that Muhme is "silent on teaching a smart card containing an identification profile of an authorized user...." and relies upon the smart card of Yeadon to overcome this deficiency.

In response, Applicants submit that Muhme is not silent on teaching a smart card, but, rather, teaches against such technique. The description at lines 12-24 and lines 65-66 of column 3 clearly reflect an environment in which the tags 20, 22 are detected via a wireless technique.

In contrast, the smart card of Yeadon is described at line 67 of column 5 through line 14 of column 6 as being used in order to allow certain information concerning each dispensing operation to be recorded.

As clearly described at lines 57-58 and 65-67 of column 6, Muhme already has the corresponding mechanism to record information. It is noted that the "tags 20, 22" of Muhme are not the "smart card" used in Yeadon, and, therefore, Applicants submit that the Examiner continues to fail to provide a reasonable motivation to modify Muhme.

That is, Applicants submit that there is no reason to consider that the tags used in Muhme are any "less secure" than the smart card used in Yeadon, as the Examiner has summarily declared in the rejection.

Moreover, as previously traversed and never responded on the record by the Examiner, the present invention actually disables the security function at that gate upon presentation of the

smart card. Applicants submit that, to one of ordinary skill in the art, such temporary disablement is a different concept from that described at line 14 of column 4 of Muhme of "deactivating" the gate lock 32. As Applicants have already pointed out, deactivation of the lock is merely one component of the normal operation of the security system in Muhme.

Hence, turning to the clear language of the claims, in Muhme there is no teaching or suggestion of: "... a smart card for being read by said reader, said smart card containing an identification profile of an authorized user of said object; and a computer attached to said reader, said computer disabling a security function of said security path at said security gate if a person presenting said smart card at said reader is determined as being authorized to remove said object after having said smart card read by said reader", as required by claim 1. Claims 15 and 21 have similar language.

Relative to the rejection for claim 8, Applicants submit that the plain meaning of the claim "... activating said video receiver upon interrogating said EAS device" would require that Muhme be modified to:

- 1) incorporate a video receiver; and
- 2) activate the video receiver whenever tag 20 is sensed.

The Examiner concedes that Muhme fails to teach or suggest using a video camera and relies upon the description at lines 18-24 of column 10 of Nelson to overcome this deficiency and alleges that it would have been obvious to add video to Muhme "... *in order to have evidence of an unauthorized person transporting an object through a security gate.*"

Applicants submit that the Examiner's rationale ignores the different environments discussed in Muhme versus Nelson. More specifically, as clearly described at lines 1-10 of column 10, the cited lines in Nelson refer to an environment in which the passageway does not include a lockable security. Rather, as described at lines 18-20 of column 10, Nelson teaches "... *an alarm could be triggered at an appropriate security location.*" Applicants submit that this environment is different from the secured gateway of Muhme.

Moreover, lines 20-24 of column 10 of Nelson merely states that "*Security is enhanced if transponder surveillance is used in combination with video surveillance so that a video record of the person transporting an item without authorization could also be obtained.*"

Applicants first submit that this description of using transponder surveillance in combination with video surveillance falls short of the plain meaning of the language in which is required that the video surveillance system of Nelson would have to be turned on by the transponder surveillance system upon its sensing the marked item.

Moreover, contrary to the Examiner's implied characterization that Muhme lacks a means to obtain "... *evidence of an unauthorized person transporting an object through a security gate.*" Applicants submit that the description at lines 33-36 of column 3 clearly obtains all the evidence necessary by entrapping the person 14 in the exit 16.

Therefore, it is submitted that the rejection currently of record fails to either provide a reasonable motivation to modify Muhme and that, even if "video surveillance" mentioned at line 22 of column 10 of Nelson were to be incorporated into Muhme, the combination would still fail to provide the description of the plain meaning of the claim language.

Hence, turning to the clear language of claim 8, in Muhme or/and Nelson, there is no teaching or suggestion of: "... further comprising a video receiver operatively coupled to said path, said path activating said video receiver upon interrogating said EAS device."

Claim 25 has similar language in which the video camera is activated upon activating the alarm. Claim 27 requires that the video image be captured whenever the smart card includes the identification profile. Claim 26 requires that the video image be captured when the alarm is turned off.

Relative to claim 9, Applicants submit that the rejection currently of record fails to incorporate a substantive evaluation of this claim completely. The plain meaning of the claim language requires that the alarm be turned off upon presentation of the smart card. Claims 24, 28, and 29 have similar language.

For the reasons stated above, Applicants submit that the claimed invention is fully patentable over the cited references.

Moreover, Applicants respectfully request that the Examiner fulfill the MPEP 707.07(f) requirement that the Examiner, prior to proceeding now to imminent Appeal, clarify and make of record a reasonably complete response to the traversals of record, including the specific traversals identified above.

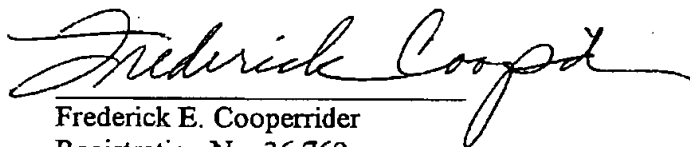
### III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-2, 4-6, 8-16, and 18-29, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



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### CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (703) 872-9306 this Amendment under 37 CFR §1.116 to Examiner V. Brown on December 7, 2004.



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